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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,470	10/27/2003	Brian Keith Cabral	MSFT-2830/191773.02	2508

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EXAMINER

WOODS, ERIC V

ART UNIT PAPER NUMBER

2672

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/694,470

Applicant(s)

CABRAL ET AL

Examiner

Eric Woods

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 November 2005 has been entered.

### ***Double Patenting***

Applicant is put on notice that the Office is requiring a terminal disclaimer with respect to US Patent 6,697,062 or all claims will be rejected in the next Office Action under grounds of double patenting.

### ***Response to Arguments***

Claims 15-70 are pending.

Applicant's arguments, see Remarks pages 1-4 and amendments, filed 10 November 2005, with respect to the rejection(s) of claim(s) 15-70 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as below.

### ***Information Disclosure Statement***

The information disclosure statement filed 7-20-1998 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it

to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-70 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter. The inventions are computer-related, which requires that the guidelines in MPEP 2106 for computer-related inventions be applied. The new, interim guidelines issued after *Ex parte Lundgren* are being used herein. MPEP 2106 clearly states that whether or not a computer-related invention is software or hardware or a computer program, it is still subject to the same set of guidelines for determining statutory subject matter. The claimed invention must generate "concrete, practical, and tangible results" according to the CAFC in *State St.* According to the first step, there is no pre- or post-computer activity. All processing takes place within the computer. Therefore, it does not fall under the safe harbors established in *State St*, *AT&T v. Excel Communications*, *Alappat*, or any other similar cases. Next, the processing does not improve the efficiency of the computer per se (*In re Lowry*), nor does it improve the efficiency of the data structures (*In re Warmerdam*, supra). As such, the claims constitute the quintessential abstract idea, in that only electrical signals are manipulated inside a computer. No data enters the computer and

none exits the computer. Even in the dependent claims, the data is sent for rendering but is never actually displayed on a display device. Therefore, the claims do not recite any input or output devices (even for the hardware), which again means that the system may be inoperative as well as being non-statutory (and it is noted that case law supports the position that an inoperative invention is also non-statutory since it would be non-functional, and similarly lack utility).

Therefore, amendment to recite a positive step (e.g. the addition of claim 18 and language to the effect that the rendered object is displayed on a display device) to produce post-computer activity is required to render the claims statutory.

In order to expedite the prosecution of the instant application and in anticipation of applicant amending the claims to place them within one of the four categories of statutory subject matter, the claims rejected above under 35 U.S.C. 101 as nonstatutory are further rejected under 35 U.S.C. 112, 102, and/or 103 (as appropriate) below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling. A computer, which is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

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Specifically, a computer is required to perform this method. This rejection can be overcome by adding the words "computer-implemented" to the preamble of claim 15 before the word "method".

### ***Definitions***

Applicant is kindly requested to provide a definition for the term 'specific' that was added to the claims and to point out the support in the instant application. Examiner is giving the term its customary meaning (dictionary) since the specification does not provide a standard for the term (AWH v. Phillips only requires that the intrinsic record be used to construe claim language where the record contains such information. Otherwise, dictionaries and other external sources of information may be concerned (e.g. *Texas Digital*) with the provision that they may not broaden claim scope and such definitions must be consistent with the intrinsic record.)

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on 571-272-7664. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eric Woods

*Jeffrey A. Brin*  
JEFFREY A. BRIN  
PRIMARY EXAMINER

January 24, 2006